

Applicant : Andreas Muth  
Appl. No. : 10/539,152  
Page : 8

### **REMARKS**

Claims 41, 43, 44, 46-48 and 53-79 are pending in the present application. Reconsideration is respectfully requested for the following reasons.

Applicant would like to thank the Examiner for taking the time for a telephone interview on January 20, 2010. As discussed in the interview, Applicant submits that a combination of U.S. Patent No. 2,997,096 to Morrison et al. and U.S. Patent No. 3,045,316 to Gilhart would not result in a method that produces at least one permanent impression and/or deformation in an insulation blanket while insulation material is curing during its passage through a tunnel furnace as the pattern rolls 35 of the Gilhart '316 patent do not form any such impression and/or deformation during curing. Accordingly, Applicant submits that the current amendment to claim 41, which was suggested by the Examiner during the telephone interview, would overcome the present rejection as a combination of the references would not include a molding device within the tunnel furnace, wherein the molding device subjects the insulation material to the controlled compaction in such a manner to produce the at least one permanent impression and/or deformation and curing of the insulation material occurs while the insulation material abuts the molding device to subject the insulation material to the controlled compaction.

Claim 60 has been objected to for including language not found in the specification. Applicant has amended claim 60 and believes that the objection to claim 60 is now obviated.

Claims 41, 43, 44, 46-48 and 53-76 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. According to the Office Action, limitations cited in the claims are "not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." The standard for rejecting claims as failing to comply with the written description requirement is described in MPEP §2163 as follows:

Applicant : Andreas Muth  
Appln. No. : 10/539,152  
Page : 9

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116.

An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

Applicant submits that the application clearly conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, Applicant was in possession of the invention as now claimed. According to the Office Action, Applicant was not in possession of “insulation material [that] enters the tunnel furnace having a rectangular cross-sectional profile” as claimed in claim 41. As pointed out in the Office Action, the present specification as filed stated that the insulation material has an “original rectangular shape.” Furthermore, the insulation material clearly has a rectangular shape as illustrated in FIG. 1. Moreover, claim 2 as originally filed in the application (cancelled during a preliminary amendment) stated that “the molding device is integrated in the conveyor unit within the curing oven, said conveyor unit comprising at least one molding element (4; 5, 6; 11) to form the impression(s) and/or deformation(s), during which process, as a result of contact, especially pressure contact, with the molding surface (12) of the molding element, the insulation material to be molded assumes a cross-sectional profile that deviates from the rectangular cross section of the incoming insulation material.” (emphasis added). Accordingly, Applicant clearly had possession of insulation material that has a rectangular cross section that enters a tunnel furnace as claimed in claim 41.

Applicant has amended claim 57 as suggested in the Office Action.

Applicant : Andreas Muth  
Appln. No. : 10/539,152  
Page : 10

Accordingly, Applicant submits that the rejection of the claims as failing to comply with the written description requirement under 35 U.S.C. §112, first paragraph, should be withdrawn.

In the Office Action, claims 41, 44, 46-48, 53-64, 67-70 and 72-74 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,997,096 to Morrison et al. in view of U.S. Patent No. 3,045,316 to Gilhart. As further discussed below, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. The test for obviousness has recently been addressed by the U.S. Supreme Court in *KSR Int'l. Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (2007). In its decision, the Supreme Court stated that the teaching-suggestion-motivation (TSM) standard developed by the Federal Circuit was no longer the sole test for determining obviousness. Nevertheless, the Court indicated that the TSM test provides helpful insights as to the obviousness of the invention.

Furthermore, according to M.P.E.P. §2142:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Applicants submit that the Office Action has not clearly articulated the reasons why the claimed invention would have been obvious.

Moreover, while the U.S. Supreme Court held that the TSM standard was not the sole standard for finding obviousness, there is at least one element to the finding of a *prima facie* case of obviousness that is common to both the TSM standard and the standards that may otherwise fall within the purview of the *KSR* decision. Specifically, each and every element of

the claimed invention must still be considered. As will be set forth below, there are elements of the claimed invention that are missing in their entirety from the cited prior art.

Amended claim 41 defines a method of producing insulation elements made of mineral wool containing curable binder. The method comprises depositing insulation material comprising mineral wool and curable binder on a conveyor, curing and transporting the insulation material through a tunnel furnace, and subjecting sections of the insulation material to controlled compaction in such a manner that at least one permanent impression and/or deformation is produced in the insulation blanket while the insulation material is curing during its passage through the tunnel furnace. The insulation material enters the tunnel furnace having a rectangular cross-sectional profile and the insulation material is impressed and/or deformed to produce a non-rectangular cross-sectional profile during curing. A molding device is within the tunnel furnace, wherein the molding device subjects the insulation material to the controlled compaction in such a manner to produce the at least one permanent impression and/or deformation and curing of the insulation material occurs while the insulation material abuts the molding device to subject the insulation material to the controlled compaction.

Applicant submits that the prior art of record does not obviate the above-noted features of claim 41. Specifically, Applicant submits that a combination of the Morrison et al. '096 patent in view of the Gilhart '316 patent does not lead to the subject matter of amended claim 41, since neither of the cited references includes a molding device within the tunnel furnace, wherein the molding device subjects the insulation material to the controlled compaction in such a manner to produce the at least one permanent impression and/or deformation and curing of the insulation material occurs while the insulation material abuts the molding device to subject the insulation material to the controlled compaction, along with the remaining features of claim 41. As discussed during the telephone interview, such an amendment to claim 41 would overcome the present rejection as the pattern rolls 35 of the Gilhart '316 patent do not form any such impression and/or deformation during curing (note the bulging of the fibers 21 after they pass the pattern rolls 35). Accordingly, claim 41 is in condition for allowance.

Applicant : Andreas Muth  
Appln. No. : 10/539,152  
Page : 12


Claims 43, 44, 46-48 and 53-79 depend from claim 41 and since claim 41 defines patentable subject matter as discussed above, claims 43, 44, 46-48 and 53-79 define patentable subject matter. Accordingly, claims 43, 44, 46-48 and 53-7 are in condition for allowance.

New claims 77-79 further define the first and/or second molding elements of claim 66 and are also believe to be in condition for allowance.

All pending claims 41, 43, 44, 46-48 and 53-79 are believed to be in condition for allowance and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,

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Date

  
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